



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,953	11/29/2000	Ricardo Guimaraes	155615-0018	1119

7590 01/10/2007
IRELL & MANELLA LLP
Suite 400
840 Newport Center Drive
Newport Beach, CA 92660

EXAMINER

ALI, SHUMAYA B

ART UNIT PAPER NUMBER

3771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/726,953

Applicant(s)

GUIMARAES ET AL.

Examiner

Shumaya B. Ali

Art Unit

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/8/2006 has been entered.

Status of Claims

In response to the previous office action, the Applicant has entered new claims 15 and 16. Currently, claims 1-16 are pending in the instant application.

Response to Arguments

Applicant amended claim 1 to incorporate “means for directing” a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not dehydrated by the flow of air. Applicant respectfully submitted that such amendment to claim 1 is deemed allowable (see remarks page 9 lines 8-11). Applicant’s arguments however not considered on the merit because incorporating the “means for directing” makes the previous recitation of “an air flow module” rather broad, thereby any equivalent air flow module that is capable of providing a flow of air above the cornea of the patient from one

Art Unit: 3771

side of the cornea to the another side of the cornea, at a distance would read on the claimed limitation. Kawesch US'754 discloses following structures as "means for directing": a dryer 200 with a source of filtered, compressed air 202, a pressure regulator 204, and a manually operated, flow restricting valve 206. These structures can be manipulated to direct a very low flow of filtered, compressed air over ("above") the repositioned corneal flap in order draw the fluid out of the cornea/flap interface and limit flow rate and associated pressure that are required to provide sufficient air flow for convective drying while, at the same time minimize the possibility of blowing the repositioned flap out of its proper position (see col.5, lines 24-37). Kawesch US'754 figure 4 clearly depicts that the means for directing a flow of air being positioned at a distance from the cornea. Thus, the amended claim 1 still considered to read on Kawesch US'754.

In further arguments Applicant presented that all depended claims of 1 and 8 are patentable over the prior art of record (see remarks page 9 lines 12-14), however as presented above, claim 1 is considered to read on Kawesch US'754, therefore such argument is not persuasive.

In further arguments Applicant presented claims 12-14 are patentable over the prior art of record due to BPAI's refusal to sustain previous rejection to claims 12-14, however claims 12-14 are considered rejected under 35 USC 103 as being obvious over Kawesch US'754 as follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3771

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawesch US 6,019,754 in view of Glockler US 6,251,101.

As to claim 1, Kawesch discloses a system that can be used to perform an ophthalmic procedure on a cornea of a patient (see figs.1-5), comprising a light source (fig.4, 102) that can direct a light beam onto the cornea of the patient, and means for directing (fig.4, 200, 202, 204, and 206) a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea (see fig.4), at a distance so that the cornea is not dehydrated by the flow of air (see

Art Unit: 3771

“manually operated...manipulated to direct...flow of..air over” in col.5 lines 26-28). Kawesch however does not disclose a patient support that can support the patient. However, it would have been obvious that the cornea is supported with some form of support during the surgery. Therefore, Kawesch is considered to teach a patient support. Furthermore, a system for ophthalmic procedure is known in the art to have a patient support. Glockler teaches a patient support table (see fig.1). Therefore, it would have been obvious to one of ordinary skill in that art at the time the invention was made to provide the system of Kawesch with a patient support so that the head of the patient will be firmly supported on, and preferably restrained by an operating table as taught by Glockler (see col.5 lines 62 and 63 of Glockler).

As to claim 2, Kawesch does not disclose a portable stand that supports the airflow module. However, Glockler discloses a portable stand (see wheels in fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Kawesch with portable stand for the purposes of allowing the use of the stand at alternative locations as taught by Glockler, and also because Kawesch teaches that “drying device 200 may be integrated into a complete laser-based vision surgery apparatus or it may be a separate, retrofit unit” (see col. 5 lines 17-19 of Kawesch)

As to claim 3, Kawesch discloses the system further comprising a control console that is coupled to said airflow module (fig.4, 200, col.3 line 57 see “control”).

As to claim 4, Kawesch discloses wherein said patient support includes a table. . However, Glockler teaches a patient support table (see fig.1). Therefore, it would have been obvious to one of ordinary skill in that art at the time the invention was made to provide the system of Kawesch with a patient support table so that the head of the patient will be firmly

Art Unit: 3771

supported on, and preferably restrained by an operating table as taught by Glockler (see col.5 lines 62 and 63 of Glockler).

As to claim 5, Kawesch discloses wherein said light source includes a laser (see “laser” in col.4 line 24).

As to claim 6, Kawesch discloses wherein said airflow module creates a laminar flow of air (see “over” in col.5 line 28).

As to claim 7, Kawesch discloses wherein said airflow module includes an adjustable blade (fig.4, 206).

As to claim 8, Kawesch discloses a system that can be used to perform an ophthalmic procedure on a cornea of a patient (see figs.1-5) comprising a laser that can direct a light beam (fig.4, 102) onto the cornea of the patient; means for directing (fig.4, 200, 202, 204, and 206) a flow of air above (see “over” in col.5 line 28) the cornea of the patient from one side of the cornea to another side of the cornea (see fig.4), at a distance so that the cornea is not dehydrated by the flow of air (see “manually operated...manipulated to direct...flow of..air over” in col.5 lines 26-28), a control console (see “control” in col.3 line 57) that is coupled to said airflow module. Kawesch however does not disclose a patient support that can support the patient. However, it would have been obvious that the cornea is supported with some form of support during the surgery. Therefore, Kawesch is considered to teach a patient support. Furthermore, a system for ophthalmic procedure is known in the art to have a patient support. Glockler teaches a patient support table (see fig.1). Therefore, it would have been obvious to one of ordinary skill in that art at the time the invention was made to provide the system of Kawesch with a patient

Art Unit: 3771

support so that the head of the patient will be firmly supported on, and preferably restrained by an operating table as taught by Glockler (see col.5 lines 62 and 63 of Glockler).

As to claim 9, Kawesch discloses wherein said patient support includes a table. . However, Glockler teaches a patient support table (see fig.1). Therefore, it would have been obvious to one of ordinary skill in that art at the time the invention was made to provide the system of Kawesch with a patient support table so that the head of the patient will be firmly supported on, and preferably restrained by an operating table as taught by Glockler (see col.5 lines 62 and 63 of Glockler).

As to claim 10, Kawesch discloses wherein said airflow module creates a laminar flow of air (see “over” in col.5 line 28).

As to claim 11, Kawesch discloses wherein said airflow module includes an adjustable blade (fig.4, 206).

As to claim 12, Kawesch discloses a method for performing an ophthalmic procedure on a cornea of a patient. Kawesch discloses all structural limitations required to perform method steps of directing a flow of air across the cornea from one side of the cornea to another side of the cornea at a distance so that the cornea is not de-hydrated by the flow of air as applied for claims 1 and 8. Kawesch further discloses the structural limitations to carry the method steps of creating a flop in the cornea (fig.2, 16), moving the flap to expose a portion of the cornea (fig.3, 16), ablating a portion of the exposed cornea with a laser beam (fig.4, 102), moving the flap back onto the cornea (see “repositioning the flap” in col.2 line 45). Therefore, the method steps cited in claim 12 would have been obvious results of using the system of Kawesch.

As to claim 13, Kawesh discloses adjusting a flow rate of the flow of air (fig.4, 206, see “flow rate” in col.5 line 31).

As to claim 14, Kawesh discloses adjusting a direction of the flow of air (fig.2, 206, see “manually operated...manipulated to direct...flow of...air over” in col.5 lines 26-28).

As to claim 15, Kawesh discloses wherein the airflow directing means include an airflow module (fig.4, 200).

As to claim 16, Kawesh discloses wherein the airflow directing means include an airflow module (fig.4, 200).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-W-F 8:30am-5:00 pm.

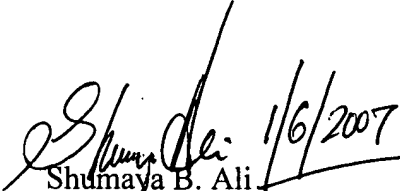
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/726,953

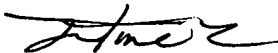
Page 9

Art Unit: 3771

 1/6/2007
Shumaya B. Ali

Examiner

Art Unit 3771


JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

1/7/07